



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Roger A. Duman

Examiner: Peter T. deVore

Serial No.: 10/722,240

Group Art Unit: 3751

Filed: November 25, 2003

Docket: G180.147.101 / GMI6164

Due Date: May 8, 2006

Title: APPARATUS AND METHOD FOR TRANSPORTING CONTAINERS
WITHIN A PACKAGING SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir/Madam:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested according to the following reasons:

In the Final Office Action mailed February 8, 2006, claims 1-9, 11-18, 20-24, 26-29, 31-35, 40-42, 44-46, 48, and 49 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Pat. No. 3,047,032 ("Carter") in view of U.S. Pat. No. 2,496,792 ("Hellberg"). Claims 19, 38, and 39 were rejected under 35 U.S.C. § 103(a) as unpatentable over Carter in view of Hellberg and U.S. Pat. No. 5,938,060 ("Rutland"). Claims 24 and 43 were rejected under 35 U.S.C. § 103(a) as unpatentable over Carter in view of Hellberg and U.S. Pat. No. 3,556,174 ("Gibble"). Claims 36 and 37 were rejected under 35 U.S.C. § 103(a) as unpatentable over Carter in view of Hellberg and U.S. Pat. No. 5,641,140 ("Sorenson").

Claim 1 relates, in part, to a method of transporting containers from a first station to a second station within a container filling system. The method includes loading a container onto a mounting piece of a carrier plate such that the mounting piece frictionally engages an inner surface of a longitudinal recess of the container. The method also includes moving the carrier plate from the first station to the second station, wherein the mounting piece secures the container relative to movement of the carrier plate. For at least the reasons described below, the cited references fail to teach or suggest such limitations.

Carter relates to an apparatus for filling containers where the apparatus includes a rotary table. *Carter* at col. 1, ll. 9-14. As the Final Office Action notes, Carter does not disclose a mounting piece frictionally engaging an inner surface of a longitudinal recess of a container, as required by the limitations of claim 1. FOA at p. 2. In fact, Carter specifically teaches away from such limitations, there would not be a reasonable expectation of success incorporating such limitations, and incorporation of such limitations would defeat the functionality of the Carter apparatus.

Pre-Appeal Brief Request for Review

Applicant: Roger A. Duman

Serial No.: 10/722,240

Filing Date: November 25, 2003

Docket: G180.147.101 / GMI6164

Title: APPARATUS AND METHOD FOR TRANSPORTING CONTAINERS WITHIN A PACKAGING SYSTEM

In particular, the Final Office Action refers to the stirrups E of Carter as a “carrier plate” and proffers that one having ordinary skill in the art would be motivated to incorporate the cover/stand 10 of Hellberg into the apparatus of Carter as a “mounting piece.” FOA at pp. 2-3. With reference to Figs. 8 and 9 of Carter, for example, it should be understood that the stirrups E of Carter are substantially flat. In particular, Carter specifically teaches that the bottles “are slid onto and off of them.” *Carter* at col. 6, ll. 18-26. Thus, Carter specifically teaches away from a mounting piece frictionally engaging an inner surface of a longitudinal recess of the container. Restated, Carter teaches flat surfaces for sliding the bottles over the stirrups. The surfaces would no longer be flat, and bottles would no longer be able to slide over the surfaces of the stirrups E, if the stirrups incorporated the cover/stand 10 of Hellberg.

Furthermore, none of Carter, Hellberg, Sorenson, Rutland, or Gible provides any guidance as to how the base/cover of Hellberg could be incorporated into the apparatus of Carter. As such, there is no reasonable expectation of success in accomplishing such a combination. In fact, such a modification would defeat the functionality of Carter. In particular, so modified, the apparatus of Carter would not allow the bottles to be slid onto and off of the rotating table of Carter using star wheels W, D. If the base/cover 10 design of Hellberg were incorporated with the stirrups E of Carter, the stirrups E would interfere with the bottles and prevent them from being released from the stirrups E. *Carter* at Figs. 1 & 2; col. 5, l. 67 – col. 6, l. 26 (describing interactions between the rotating table, star wheels W, D, and stirrups E).

As it is improper to modify references where the references teach away from such modification, and it is improper to make a modification if the proposed modification would render a prior art invention unsatisfactory for its intended purpose, a prima facie case of obviousness has not been established. MPEP § § 2141.01, 2143.01.

Additionally, in order for a reference to be used as prior art under 35 U.S.C. § 103, the reference must be analogous art to the application. Two factors determine whether a reference is analogous art: (1) whether the art is from the applicant’s field of endeavor, regardless of the problem addressed or (2) whether the reference is reasonably pertinent to the particular problem with which the applicant is concerned. MPEP § 2141.01. For at least the reasons described below, Hellberg is non-analogous art to the present invention.

With respect to the first factor, Hellberg “relates to coffee brewers” and “provision of an improved device to serve as a combination cover and stand for the upper bowl of a vacuum coffee brewer.” *Hellberg* at col. 1, l. 1. In direct contrast, the present application relates to container packaging

Pre-Appeal Brief Request for Review

Applicant: Roger A. Duman

Serial No.: 10/722,240

Filing Date: November 25, 2003

Docket: G180.147.101 / GMI6164

Title: APPARATUS AND METHOD FOR TRANSPORTING CONTAINERS WITHIN A PACKAGING SYSTEM

systems and transporting containers within a packaging system. *Specification* at pg. 1, l. 5. Clearly, the provision of combination cover-stands for coffee brewers is not in the same field of endeavor as the transportation of containers within a packaging system, such that the first criterion is not satisfied.

With respect to the second factor, Hellberg is implicitly concerned with supporting bowl 14 on a stationary surface (i.e., where coffee makers are typically placed) “such that tipping of the bowl 14, due to ordinary overbalancing forces acting upon it, is avoided.” *Hellberg* at col. 2, ll. 18-20 (emphasis added). In turn, the present application addresses problems associated with mounting techniques used when transporting containers within a packaging system. For example, the present application addresses the need to rigidly maintain frustoconical or otherwise tapered containers as a drive system transports the containers to various stations to impede or prevent the container tipping during transportation (*E.g.*, *Specification* at p. 15, ll. 9-10; p. 14, ll. 1-3) and the need to avoid trapping air that might otherwise be entrapped as a container is forced onto a mounting piece such that a possible impediment to complete mounting of the container is avoided (*E.g.*, *Specification* at p. 14, ll. 3-8). Thus, Hellberg is not reasonably pertinent to the particular problem with which the applicant is concerned, as Hellberg implicitly relates to different problems associated with supporting stationary coffee maker bowls. As neither the first nor the second factors are met, Hellberg presents non-analogous art to the present application. For at least such additional reasons, a prima facie -obviousness has not been established.

In light of the above clarifications, the grounds for rejecting independent claim 1 are believed fully traversed. Independent claims 26 and 44 relate, in part, to limitations similar to those described above in association with independent claim 1. As such, they are believed patentably distinct from the cited references for at least the reasons described above in association with claim 1. Furthermore, dependent claims 2-25, 27-43, and 45-49 depend, in some form, from one of claims 1, 26, and 44. As such, those dependent claims are also believed patentably distinct from the cited references. In sum, the rejection of claims 1-9, 11-29, 31-46, 48, and 49 is believed fully traversed. Withdrawal of the rejection, allowance, and notice to that effect are respectfully requested.

Additionally, the dependent claims can be further distinguished from the cited references. For example, claims 36 and 37 stand rejected under 35 U.S.C. § 103 as unpatentable over Carter in view of Hellberg and further in view of Sorenson. Claim 36 relates to a mounting piece including a shoulder extending from a base opposite a carrier plate, the shoulder having a maximum transverse outer dimension less than a maximum transverse outer dimension of the base, the base and the shoulder being rings having co-axial central passages. Claim 37 relates, in part, to the carrier plate forming an aperture,

Pre-Appeal Brief Request for Review

Applicant: Roger A. Duman

Serial No.: 10/722,240

Filing Date: November 25, 2003

Docket: G180.147.101 / GMI6164

Title: APPARATUS AND METHOD FOR TRANSPORTING CONTAINERS WITHIN A PACKAGING SYSTEM

and the mounting piece being assembled to the carrier plate such that the central passages are co-axially aligned with the aperture. For at least the additional reasons provided below, the cited references fail to teach or suggest such limitations.

The Office Action indicates that one having ordinary skill in the art would be motivated to modify the combination of Carter and Hellberg “for greater surface area/friction between the container and carrier plate” such that “the base and shoulder are rings having co-axial passages which form an aperture....” FOA at pp. 4-5. With the tacit understanding that the Office Action is referencing the bowl 30c (shown in Figs. 9 and 10 of Sorenson) as a “mounting piece,” it is unclear how the bowl 30c provides “greater surface area/friction” than the cover/stand 10 of Hellberg. In fact, following a good faith review of the references cited, there is no teaching or suggestion providing such a conclusion as to the function/effect of the structure of the bowl 30c in the prior art. Further, the Examiner has not identified any teaching in the prior art of a carrier plate that forms an aperture as required by claim 37. The Examiner has only referenced “wherein the mounting piece forms a ring having a central aperture.” FOA at p. 5. Thus, there would be no motivation to modify Hellberg. Additionally, there would be no motivation to combine Sorenson with Carter as the sliding functionality between the containers and stirrups E of Carter would be defeated by incorporating the bowl 30c of Sorenson. As such, dependent claims 36 and 37 should be deemed allowable for at least such additional reasons.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-3, 7-15, 19-27, 31-38, 42-46, and 48-49 are all in a condition for allowance and requests reconsideration of the application and allowance of all pending claims.

Any inquiry regarding this Amendment and Response should be directed to Timothy A. Czaja at Telephone No. (612) 573-2004, Facsimile No. (612) 573-2005 or

Pre-Appeal Brief Request for Review

Applicant: Roger A. Duman

Serial No.: 10/722,240

Filing Date: November 25, 2003

Docket: G180.147.101 / GMI6164

Title: APPARATUS AND METHOD FOR TRANSPORTING CONTAINERS WITHIN A PACKAGING SYSTEM

Dicke, Billig & Czaja, PLLC
Fifth Street Towers, Suite 2250
100 South Fifth Street
Minneapolis, MN 55402

Respectfully submitted,

Roger A. Duman,

By his attorneys,

DICKE, BILLIG & CZAJA, PLLC
Fifth Street Towers, Suite 2250
100 South Fifth Street
Minneapolis, MN 55402
Telephone: (612) 573-2004
Facsimile: (612) 573-2005

Date: May 9, 2006
TAC:jmc

Timothy A. Czaja
Reg. No. 39,649

CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Mail Stop A7, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 8 day of May, 2006.

By Timothy A. Czaja
Name: Timothy A. Czaja